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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,929	04/14/2006	Klaus Schultes	285437US0PCT	7074

  

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.		
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ALEXANDRIA, VA 22314		

  

EXAMINER	
REDDY, KARUNA P	

  

ART UNIT	PAPER NUMBER
1796	

  

NOTIFICATION DATE	DELIVERY MODE
01/31/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/575,929

Applicant(s)

SCHULTES ET AL.

Examiner

Karuna P. Reddy

Art Unit

1796

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 24-47.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

***Attachment to Advisory Action***

1. Applicants' amendment filed 1/11/2008 has been fully considered; however, the amendment has not been entered given that it introduces new issues / new matter that would require further consideration and/or search.
2. With respect to other new issues, claim 30 introduces the new term "introduces" and "into the polymer mixture". With respect to new matter, the terms "introduces" and "into the polymer mixture" are not supported by the specification as originally filed.
3. In the interest of better enabling the applicants to assess the patentability of their claims, the following advisory is given:

Specifically, applicant argues that (A) polymer matrix of present invention does not contain a thermoplastic polycarbonate while it is a primary component of the patent; (B) polymer matrix (iii) and (iv) must at least comprise (co)poly(meth)acrylimide or mixtures of (co)poly(meth)acrylimide with components (i) and (ii); (C) methyl methacrylate is a possible monomer for grafting onto a rubber base and such a polymer is not within the scope of components of present claims; (D) Rhein et al does not teach or suggest polymer materials identified in present claims as (i), (ii), (iii) and (iv) having a Vicat Softening point of at least 104<sup>0</sup>C; and (E) there is no motivation to combine the impact modifier of Suetterlin et al to the composition disclosed by Kress et al.

With respect to (A), it is noted that independent claim 24 contains the phrase "polymer mixture comprising" and is open-ended. Therefore, polymer mixture of the present claims can comprise components of the polymer matrix i.e. (i) or (ii) or (iii) or (iv) as well as other components such as "polycarbonate". Furthermore, while it is recognized that the phrase "consisting essentially of", in relation to polymer matrix, narrows the scope to specified materials and those which do not materially affect the basic and novel characteristics of the claimed polymer matrix, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. polycarbonate, would in fact be excluded from the polymer matrix and that such ingredients would materially change the characteristics of the applicant's invention, See MPEP 2111.03. Applicant is advised to submit clear and convincing evidence in the form of a declaration that "polycarbonate" would materially affect the basic and novel characteristics of applicant's invention.

With respect to (B), polymer matrix of present claims consists essentially of (i) or (ii) or (iii) or (iv). Thus, it is apparent that (co)poly(meth)acrylimide or mixtures of (co)poly(meth)acrylimide with components (i) and (ii) are not required as alleged by the applicant.

With respect to (C), it is the examiner's position that claims as recited do not exclude graft copolymers comprising methyl methacrylate as a component

which can read on the (meth)acrylate copolymer of polymer matrix .

Furthermore, the rubbery material can also be an acrylic polymer (column 4, lines 55-57).

With respect to (D), see paragraph 9 of office action mailed 10/12/2007 wherein it is noted that Vicat Softening point in example 1 is 112<sup>0</sup>C and the molding material is a thermoplastic acrylic molding material.

With respect to (E), ample motivation is provided for adding the impact modifier of Suetterlin to the composition of Kress et al. See paragraph 7, page 5, lines 3-7 of office action mailed 5/21/2007, wherein it is noted that impact modifier when mixed with thermoplastic molding compound yields molded articles exhibiting reduced susceptibility to stress whitening and improved impact strength.

/Karuna Reddy/

1/24/2008

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